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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,931	01/24/2001	Satoshi Kanayama	55551-CIP(1360)	3848

7590 11/21/2002

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EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

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DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-10

<b>Office Action Summary</b>	Application No. 09/768,931	Applicant(s) KANAYAMA ET AL.	
	Examiner David Buttner	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 September 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> | 6) <input type="checkbox"/> Other:  |

The PCT priority document has not been received.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The application claims benefit to international application JP/99/04007 filed 7/27/99. Applications filed on or after 1/29/00 that claim benefit to an earlier filed international application must include in the first sentence of the specification an indication of whether the international application was published in English under PCT Article 21(2). See 37 CFR 1.78(a)(2). The indication is missing.

The oath refers to copending application 9-744285 with an incorrect filing date. The actual filing date for that applications is 3/12/01. That date is later than the filing date of the instant application. Applicant cannot claim a later filed application as a parent.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is not further limiting.

Applicant's remarks indicate claim 1's description of (b) is limited to solely one aliphatic diol. However, the claim uses the phrase "comprising at least". This allows for more than one kind of diol.

Claims 1-13, 20, 22, 23 and 25 are rejected under 35 U.S.C. 102(b,e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Harada Patent.

Harada blends copolyester with polycarbonate in a 2/98 to 95/5 ratio (col. 8, line 4). The polyester has 30-90% of its acid being naphthalene dicarboxylic acid (col. 3, line 30). Example 88 and comparison 25 are particularly relevant. Stabilizers (col. 5, lines 16-17) can be present.

Claims 1-5 and 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Harada Patent in view of Allen and Hirose.

Harada does not suggest sterilizing his blend or adding radiation stabilizers.

Allen teaches (col. 2, line 26) blends of PC and copolyester can be sterilized by radiation. Also note Allen suggests naphthalene dicarboxylic acid units (col. 4, line 41) in the copolyester.

Hirose teaches a certain radiation stabilizer for PC/polyester blends (col. 7, lines 15-20). Furthermore, Hirose teaches other stabilizers such as phosphates (col. 6, line 5), triazines, phenols (col. 7, line 31) and ester lubricants (col. 7, line 30) are appropriate inclusions.

It would have been obvious to include any common additive to Harada's blend for the expected advantages and irradiate the final product for sterilization

Claims 1-19 and 21-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Harada Patent in view of Mizutani.

Harada does not suggest lubricants/release agents for his PC composition. Mizutani lists many release agents known for use with PC (col. 5, lines 1-21). Use of any of these fatty acid esters and/or fatty alcohol esters would have been prima facie obvious.

Mizutani also teaches PC is radiation sterilizable with the inclusion of polyester radiation stabilizers and phosphates (col. 5, line 22).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 and 22 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 9-744285. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim essentially the same composition, with the instant application requiring aliphatic diol and the copending application open to any diol.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-12 and 22 of this application conflict with claims 1-9 of Application No. 9-744285. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Applicant's arguments filed 9/3/02 have been fully considered but they are not persuasive.

Applicant has not provided a suitable title. "Thermoplastic Resin Composition" conveys virtually no information about the composition. A proper title would include "naphthalene carboxylic acid" in some manner.

Applicant did not amend the specification to indicate if the international application was published in English.

Applicant argues Harada requires two diols to be present in order to meet certain solubility requirements.

This may be true. However, applicant's claims do not clearly limit the polyester to having only a single diol. The specification calls for mixtures of diols (paper 11 line 5). The claim uses the phrase "comprising at least" when describing the acids and diol.

The examiner agrees that PET does not meet the current limitations for (a).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

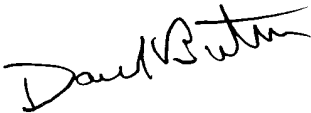
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 703-308-2403. The examiner can normally be reached on Weekdays from 10:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

D. Buttner/mn  
November 20, 2002

  
DAVID J. BUTTNER  
PRIMARY EXAMINER